

1 frame, and does not disclose or remotely suggest spraying a second quantity of adhesive onto  
2 a folded flap of a corner protector to secure a pair of the corner protector flaps together.

3 Kuhn et al., U.S. Patent No. 5,711,426 discloses a corner protector "apparatus,"  
4 consisting of a planar sheet or blank of cardboard which is folded into panels that are  
5 adhesively secured together to form a generally rectangularly-shaped box-like structure which  
6 is severable into two smaller, generally rectangularly-shaped box-like corner protectors 16 and  
7 17 (Figures 3 and 5), or four smaller, generally rectangularly-shaped box-like corner protectors  
8 16', 16", 17', 17". After individual corner protectors are fabricated and severed from one  
9 another as described above, a separate corner protector is "temporarily held in place (on each  
10 corner of) an article, by a further strip of adhesive tape, etc." Thus, Kuhn does not disclose,  
11 or even remotely suggests either folding a corner protector pre-form or blank *in situ* around the  
12 corner of a frame, does not disclose or remotely suggest depositing a first quantity of adhesive  
13 onto the frame to secure a flap of a corner protector to the frame, and does not disclose or  
14 remotely suggest depositing a second quantity of adhesive onto a folded flap of the corner  
15 protector to secure a pair of flaps of the corner protector together.

16 Doll, U.S. Patent No. 3,725,170 discloses a method and apparatus for forming  
17 corner pads from plies which are folded from a planar sheet and nested into a trihedral angle  
18 arrangement, as for example by spraying hot melt adhesive "onto the forward facing surfaces  
19 of certain of the plies." Doll does not disclose or even remotely suggest either folding a corner  
20 protector pre-form or blank *in situ* around the corner of a frame, and does not disclose or  
21 remotely suggest depositing a first quantity of adhesive onto a frame to secure a flap of the  
22 corner protector onto the frame.

23 Applicant respectfully disagrees with the examiner's statement that "Parcels ('934)  
24 has the same inventive entity as the present application." While the examiner correctly  
25 identifies similarity if not identity between certain components of the apparatus in Parcels '934  
26 and those of the claimed apparatus, it is well understood that the patentability of the vast  
27 majority of inventions is predicated on a novel combination of known elements which interact

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1 synergistically to produce a useful result. Thus, for example, there are countless numbers of  
2 valid patents issued for machines or mechanisms which consist entirely of novel combinations  
3 of components which have existed since ancient times, e.g., pulleys, gears, levers, wheels,  
4 belts, etc. Moreover, many important inventions for which valid patents have issued contain  
5 claims which recite a large number of interacting elements, and a single additional common  
6 element which results in a novel, non-obvious entity which is thus enabled to perform a known  
7 function in an improved way, or perform a different or additional function. Moreover, identical  
8 known elements can be combined in a virtually limitless variety of ways to produce novel, non-  
9 obvious advantageous and synergistic combinations which are patentably distinct over  
10 combinations of identical elements. Accordingly, a comparison of component lists between  
11 a claimed structure and a prior art structure cannot of itself be determinative of patentability.  
12 Thus, it is submitted that even the examiner's statement that "the apparatus of *Parcels* ([934]  
13 is identical to that of the present invention . . . . except that *Parcels* teaches a movable staple  
14 head for stapling the folded flaps of the corner protector instead of means for depositing an  
15 adhesive onto the flaps." is incomplete and therefore only partially correct. The underlined  
16 portion of the above-cited examiner's statement corresponds to element d. of amended Claim  
17 18, i.e., means for depositing a second quantity of adhesive onto an upper surface of said  
18 securement flap overlying said first quantity of adhesive. It is submitted that the structure  
19 defined by this means plus function clause defines *per se* an apparatus which is patentably  
20 distinct over *Parcels* '934, considered either separately or in any combination with the prior art  
21 of record. However, it should be noted that amended Claim 18 recites three additional means  
22 plus function clauses, namely a, g, and h. It is submitted that the structure defined by any one  
23 of the four aforementioned means-plus function clauses relates synergistically with the  
24 structure defined by the remaining clauses of amended Claim 18 to describe an apparatus  
25 which is a novel, non-obvious and advantageous advancement over all of the prior art of  
26 record.

1           The examiner has also stated that it is known in the art to join the folded flaps of  
2 corner protector using either staples or adhesive, as taught by the prior art referred to by Kuhn  
3 . . . and "it is also known in the art to apply adhesive to the flaps of a corner protector using  
4 means such as movable spray nozzles prior to joining the same as taught by Doll. . . ."  
5 Although the foregoing statement is correct, it should be recognized that the relatively complex  
6 machine disclosed in Doll has its sole capability the forming of a corner pad from a sheet of  
7 material, and that the sole inventive entity disclosed in Kuhn is a particular type of corner  
8 protector and method for forming the corner protector. No means are disclosed or remotely  
9 suggested in Kuhn et al. and/or Doll for folding *in situ* a pre-form into a functional corner  
10 protector onto a frame corner, and securing the corner protector *in situ* onto the frame. It  
11 should be noted that corner protectors formed according to the teachings of Doll and Kuhn  
12 must be transported manually or by undisclosed mechanical means to a frame corner for  
13 installation thereon, and, as stated above, nothing in Kuhn and/or Doll discloses or suggests  
14 an apparatus which includes any of the means clearly set forth in subparagraphs a, b, c, d, e,  
15 f, g, and h of amended Claim 18.

16           Also, applicant respectively disagrees with the examiner's statement that "One  
17 reading *Parcels* ('934) as a whole would have appreciated that the reference is concerned with  
18 the parts of the apparatus used for folding the flaps of a corner protector about a corner of the  
19 frame and not with the means for attaching the folded flaps together; . . ." The title,  
20 specification, claims and drawings of '934 are replete with descriptions of a Method And  
21 Apparatus For Attaching Corner Protectors To Picture Frames. The method and apparatus  
22 disclosed in *Parcels* '934 clearly indicate that folded flaps of corner protectors are attached to  
23 one another by the same staple which attaches the corner protector to the frame.

24           The examiner goes on to state that . . . "therefore, it would have been obvious to use  
25 means for depositing adhesive as an alternative to staples for attaching the folded flaps of the  
26 corner protectors of *Parcels* because such is known in the art, as taught by Kuhn and Doll, and  
27 adhesive provides a more aesthetically pleasing product because unlike staples, it would not  
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1 be visible to the user." Even granted that an aesthetically "pleasing product" were  
2 contemplated by Kuhn, Doll, or others, no such statement is included in those or any of the  
3 prior art references. And, as stated above, neither Kuhn, Doll, Parcels '934 or any of the other  
4 prior art of record discloses or remotely suggests an apparatus which deposits separate  
5 quantities of adhesive onto a frame and the flap of a corner protector folded *in situ* over a  
6 frame corner. That capability enables the claimed apparatus to attach corner protectors to  
7 picture frames at a vastly improved production rate over all of the prior art of record.  
8 Accordingly, it is submitted that amended Claims 18, 20-27, and 32-36 clearly define an  
9 apparatus which is a novel and non-obvious advancement over any combination of Parcels  
10 '934, Kuhn et al. and Doll.

11           Regarding the rejection of Claim 18, 20-27, and 32-36 under the judicially created  
12 doctrine of obviousness-type double patenting as being unpatentable over Claims 23-27 and  
13 29-40 of U.S. Patent No. 6,418,700 to Parcels in view of Kuhn et al. and Doll et al., the  
14 following comments are submitted. Parcels '700 discloses an automatic tandem corner  
15 protector attachment method and apparatus for picture frames and the like. Nothing in Parcels  
16 '700 discloses or remotely suggests any of the novel features of an apparatus for adhesively  
17 attaching corner protectors onto picture frames. The differences between the present  
18 invention and Parcels '700 are identical to the differences explained in detail above with  
19 reference to Parcels '934, and which for the reasons pointed out above, patentably distinguish  
20 the presently claimed invention over the subject references.

21           In view of the remarks above, it is submitted that Claims 18, 20-27 and 32-36  
22 clearly recite an apparatus which is a novel and non-obvious advancement over all of the prior  
23 art of record. Therefore, early notice of allowance of the aforementioned claims, and prompt  
24 advancement of this application to issuance are earnestly solicited.

25 Respectfully submitted,



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